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Please find below and/or attached an Office communication concerning this application or proceeding.

REST AVAILABLE COPY

Office Action Summary	Application No.	Applicant(s)	
	09/974,746 	CARTMELL ET AL.	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 October 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-87 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 October 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>02/22/02</u>	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

1. Claims 1-87 are presented for examination; claims 1, 38, 55, 60, 62, 63, and 79 independent.

Specification

2. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (for example, page 4). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 55-59, 62, and 79-87 rejected under 35 U.S.C. 101 because they recite non-statutory subject matter.

With respect to claims 55-59, and 79-87 the term "computer-readable medium" includes mediums which are non-tangible (i.e. transmission medium transmitting a generated data signal containing the contents, as shown in claims 58 and 86). A data signal is not tangible and cannot be patented. See MPEP 2106 regarding computer-implemented which must be tangibly embodied on a computer storage medium. Applicant is advised to cancel claims 58 and 86 and amend "computer-readable medium" to be a medium embodied on a computer storage device.

With respect to claim 62, this claim is a means-plus-function claim, and as required by 35 USC 112, sixth paragraph, the "means" can be construed as a non-tangible transmission medium as shown in claims 58 and 86. Correction is required.

With further respect to claims 79-87 it should be noted that this invention is merely a data structure, which is not patentable, as that all that is claimed is static data (i.e. a data structure containing a multiplicity of entries which can be matched). Correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 6-17, 20-30, and 37-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marguiles et. al (USPN 6,560,596) (hereinafter Marguiles) in view of Tan et al. (USPN 6,314,469) (hereinafter Tan).

6. Referring to claim 1, Marguiles discloses a computer-implemented method for registering multilingual domain names that include non-ASCII characters (col. 9, lines 30-45; col. 13, line 65 to col. 14, line 8), the method comprising:

receiving a request from a user to register a multilingual domain name in a top-level domain (TLD) (i.e. co.jp), the multilingual domain name having a specified second-level domain name portion that is composed of non-ASCII characters from a specified non-ASCII character set (i.e. national encodings as shown in col. 9, lines 30-45), each character in the specified character set having an associated numeric value (an inherent feature, since all data on the Internet is transmitted in binary language, which has a numeric value of either 0 or 1), the second-level domain name portion indicated in the received request by a sequence of the numeric values that are associated with the non-ASCII characters of the second-level domain name portion (i.e. receive a key in an original encoding, corresponding to a transmitted domain name in a national encoding) (col. 8, lines 25-45; col. 13, line 65 to col. 14, line 10);

generating a universal compatible encoding for the specified second-level domain name portion based on the specified character set and the indicated numeric sequence for the second-level domain name portion based on the specified character

set and the indicated numeric sequence for the second-level domain name portion (i.e. convert an original encoding to the universal encoding) (col. 8, lines 5-43);

constructing a Unicode domain name whose second-level domain name portion is the generated universal compatible encoding and whose top-level domain name portion is the TLD (this registration occurs in the TLD, and therefore the top-level domain name inherently is the TLD) (col. 8, lines 5-43);

determining whether the constructed Unicode domain name is available to be registered in the TLD and whether the indicated numeric sequence has already been reserved for another multilingual domain name registered in the TLD (i.e. lookup entry in the database, and if is already there, reject entry, new registrations may not conflict with any existing registration) (col. 8, lines 5-43; col. 14, lines 5-8);

when it is determined that the constructed Unicode domain name is available to be registered and the indicated numeric sequence has not been reserved, registering the multilingual domain name in the TLD by generating multiple distinct numeric sequence variants (the Office takes this to be construed as "generate other national encodings of the universal encoding") as equivalents for the specified domain name portion of the multilingual domain name, each generated numeric sequence variant consisting of a sequence of numeric values (i.e. convert from universal encoding to all encodings in the database, currently frequently used on the internet, typically those found in RFC 1700) (Figure 5A, col. 13, line 65 to col. 14, line 16); and

reserving (i.e. store each of the set of common internet encodings) the generated numeric sequence variants for the multilingual domain name col. 14, lines 1-16).

Marguiles does not specifically convert the multilingual domain name from a non-ASCII character set to ASCII, rather converting it into Unicode. In analogous art, Tan discloses another method of multi-language domain name service which discloses conversion from a non-Unicode format into Unicode, and then from Unicode into ASCII (e.g. abstract; col. 3, lines 25-35). It would have been obvious to one of ordinary skill in the art to combine the teaching of Tan with Marguiles in order to convert the non-ASCII character set multilingual domain name into ASCII in order to allow many linguistic encodings to be used in the DNS system, without unnecessarily modifying the DNS code and all future client applications to utilize Unicode format, rather keeping the ASCII format, thereby reducing possible difficulties as modifying all DNS servers as well as utilizing client applications which already have strong followings as supported by Tan (col. 2, lines 41-54).

7. Referring to claim 2, Marguiles discloses preventing registration of the multilingual domain name in the TLD when it is determined that the indicated numeric sequence has already been reserved (Figure 4A, ref. 403).

8. Referring to claim 3, Marguiles discloses the generating of the numeric variants is performed before the registering of the multilingual domain name, and the registering is performed only if it is determined that none of the generated numeric variants has already been reserved (Figure 4B, refs. 408-409, note the storage is done after the variant checks).

9. Referring to claim 4, Marguiles discloses the generated numeric sequence variants include the indicated numeric sequence (i.e. the requested format is inherently generated, otherwise the Unicode format would not be able to be generated, it must be stored and converted from the indicated numeric sequence variant) (Figure 4A, ref. 401).

10. Referring to claim 6, Marguiles in view of Tan disclose the invention substantively as described in claim 1. Marguiles in view of Tan shows an example of registering only a single domain name (see col. 13, line 65 to col. 14, line 10). However it has been held obvious to duplicate parts or steps for multiple effects - St. Regis Paper Co. v. Bemis Co., 193 USPQ 8 (7th Cir. 1977). By this rationale, one of ordinary skill in the art would recognize the benefits of registering multiple domain names. Furthermore Marguiles discloses that new registrations may not conflict with any existing registrations (col. 14, lines 5-8), and that if an encoding is found in the database, reject the entry (Figure 4A-B, ref. 405-407).

11. Referring to claim 7, Marguiles in view of Tan disclose the invention substantively as described in claim 1. Marguiles further discloses registering the Unicode Domain name in the TLD (Figure 4A ref. 408), Marguiles does not disclose specifically registering an ASCII domain name, however the reference states storing encodings commonly used on the Internet, which includes ASCII (col. 14, lines 1-16, 23-25).

Therefore one of ordinary skill in the art would logically understand that the ASCII encoding would be one of the encodings that would have been stored.

12. Referring to claim 8, Marguiles discloses associating an IP address with the reserved numeric sequence variants (an inherent feature to any DNS server is the association of an IP address with a domain name, otherwise the DNS server will be unable to relay the appropriate information to satisfy the query to the requestor) (col. 12, line 55 to col. 13, line 25).

13. Referring to claim 9, Marguiles discloses associating a server computer (i.e. user09.dialup.mindspring.com) with a multilingual domain name (col. 12, line 55 to col. 13, line 25).

14. Referring to claim 10, Marguiles discloses each of the multiple distinct character sets are associated with one or more encoding systems that each assign a numeric value that is unique within that encoding system to each character in that associated character set, and wherein the numeric values that are associated with the non-ASCII characters are the unique numeric values assigned to those characters by an encoding system associated with the specified character set (i.e. utilizing a system to convert into different database encodings) (col. 9, lines 30-60).

15. Referring to claim 11, Marguiles discloses determining one or more alternative second-level domain name portions that correspond to the specified second-level domain name portion and determining at least one numeric sequence variant (i.e. utilize the internet encodings of the Unicode value) (col. 14, lines 1-8).

16. Referring to claim 12, Marguiles discloses the numeric sequence variants includes determining one or more numeric sequences that vary as to reflect case-folding of characters (differ in their presentation but have very similar semantics) (col. 8, line 45 to col. 9, line 20).

17. Referring to claim 13, Marguiles discloses determining a character set distinct from the specified character set that includes some or all of the non-ASCII characters (i.e. utilizing the various encodings that all reflect various Japanese language encoding schemes) (col. 9, lines 30-40).

18. Referring to claim 14, Marguiles discloses generating an alternative set of numeric values associated with some or all of the non-ASCII characters that compose the domain name portion (i.e. variants such as half- and full-width characters in some Asian character sets) (col. 8, lines 60-67).

19. Referring to claim 15, Marguiles discloses determining characters of a character set distinct from the specified character set whose meaning is related to a meaning of

some or all of the non-ASCII characters (i.e. multiple forms of the same character that differ only in their presentation but have very similar semantics) (col. 8, lines 52-55).

20. Referring to claim 16, Marguiles discloses determining a mistake made in selecting some or all the values that are included in the numeric sequence to reflect an association (i.e. the example used is a use might expect any of "china trade", "China Trade", "chinatrade" or "china-trade", all of which are equivalent to one another under certain circumstances) (col. 8, lines 50-53).

21. Referring to claim 17, Marguiles discloses reserving the numeric sequence variants includes registering domain names in the TLD whose second-level domain name portions are the generated numeric sequence variants (i.e. convert them into the internet encodings) (col. 14, lines 1-10).

22. Referring to claims 20-22, Marguiles discloses using the registered multilingual domain name by receiving a request to resolve a domain name that is identified only by a second sequence of numeric values (i.e. legacy queries) (col. 14, lines 20-25), determining that the identified second sequence corresponds to the domain name by matching one of the reserved variants and responding to the received request by returning the IP address of a server computer for the domain name (i.e. simple match in the database) (col. 14, lines 35-45).

23. Referring to claim 23, Marguiles in view of Tan disclose the invention substantively as described in claim 20. Marguiles in view of Tan does not specifically disclose that the DNS server will redirect a user to a particular URL, however this feature is well known in DNS systems utilizing an HTTP REDIRECT request to a particular server. By this rationale, "Official Notice" is taken that both the concepts and advantages of indicating a redirect to a server is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to modify the system of Marguiles and Tan in order to include a redirect command in order to implement various standards well known in Domain Name Systems,

24. Referring to claim 24, Marguiles in view of Tan disclose the invention as described in claim 20. Marguiles and Tam do not explicitly state associating the ASCII compliant encoding with each particular variant, however Marguiles does disclose store each registration in Unicode and in each of a set of common Internet encodings (col. 14, lines 1-3). This would lead one of ordinary skill in the art that each particular encoding is, in itself, a new DNS entry, complete with response information corresponding to the ACE and the particular response information.

25. Referring to claim 25, Marguiles discloses that the second sequence of numeric values is the sequence of numeric values that was included in the indication of the second level domain name portion of the domain name (i.e. if the incoming request is

encoded in the same format, then the requesting domain address and the matching address will be the same) (col. 14, lines 1-10).

26. Referring to claim 26, Marguiles in view of Tan discloses the invention substantively as described in claim 20. Marguiles in view of Tan do not specifically disclose selecting a default IP address based on a failure to identify an associated IP address, however this is a well known feature in the networking art (i.e. selecting a default or "wildcard" address when no match is found). By this rationale, "Official Notice" is taken that both the concepts and advantages of utilizing default IP addresses is well known in the art. It would have been obvious to one of ordinary skill in the art to modify the teaching of Marguiles and Tan in order to incorporate using default IP addresses in order to supply at least some form of a response to the user, possibly in order to assist the user in finding where this page has migrated to, such as a help page for the domain.

27. Referring to claim 27, Marguiles in view of Tan discloses the invention substantively as described in claim 26. Marguiles in view of Tan do not specifically disclose returning the default IP address to the web browser of the second user, however this is a well known feature in the networking art (i.e. allowing a user to be directed to a common page, such as a help page for the domain). By this rationale, "Official Notice" is taken that both the concepts and advantages of utilizing default IP addresses is well known in the art. It would have been obvious to one of ordinary skill in

the art to modify the teaching of Marguiles and Tan in order to incorporate using default IP addresses in order to supply at least some form of a response to the web browser, possibly in order to assist the user in finding where this page has migrated to, such as a help page for the domain.

28. Referring to claim 28, Marguiles discloses determining the response information after receiving the second request (col. 13, lines 1-25).

29. Referring to claim 29, Tan discloses determining information about the domain name by using values of one or more HTTP header fields that are part of the received request (col. 10, lines 30-40).

30. Referring to claim 30, Tan discloses determining information about the domain name by using information in a specified URL other than a domain name portion of the URL (i.e. the encoding type) (col. 12, lines 33-45).

31. Referring to claim 37, Marguiles discloses the specified character set is a multi-byte character set (i.e. the encodings used in Japan are multi-byte character sets) (col. 13, lines 40-45).

32. Claims 38-63 are rejected for similar reasons as stated above.

33. Referring to claims 64-65, Marguiles discloses not receiving a character encoding scheme in the request (col. 2, lines 15-20), and furthermore if the scheme is not received, it also cannot be determined.

34. Claims 66-87 are rejected for similar reasons as stated above.

Claims 5, 18, 19, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marguiles in view of Tan in view of Broadhurst (USPN 6,560,634).

35. Referring to claim 5, Marguiles in view of Tan disclose the invention substantively as described in claim 1. Marguiles in view of Tan furthermore disclose receiving an indication of interest in registering a multilingual domain name that includes characters from a non-ASCII character set (Marguiles, col. 8, lines 25-45; col. 13, line 65 to col. 14, line 10). Marguiles in view of Tan do not specifically state, providing a web page which includes a field from which the user can specify the second level domain name portion from the specified character set and receiving the request from the web browser based on an indication from the user. In analogous art, Broadhurst discloses another method of determining availability of domain names which displays an internet web page in a web browser with a field to specify a second level domain name portion and receiving the request based on an indication from the user (i.e. pressing the search button) (e.g. abstract; Figure 5B). Although Broadhurst does not utilize non-ASCII characters, it is well known that browsers can handle non-ASCII characters (i.e. Netscape, Microsoft

Explorer, etc.). By this rationale, "Official Notice" is taken that both the concept and advantages of providing non-ASCII characters into an HTML text box of Broadhurst is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to modify the teaching of Broadhurst taken in context with Marguiles and Tam in order to allow users in different countries the ability to utilize the web page of Broadhurst, in order to determine if various domain names have been registered.

36. Referring to claim 18, Marguiles in view of Tam disclose the invention substantively as described in claim 1, however do not specifically disclose receiving an indication from the user of one or more types of variants to reserve. In analogous art, Broadhurst discloses receiving an indication (i.e. selecting the "register now" hyperlink for the particular domain name) (Figure 6A, ref. 610). It would have been obvious to one of ordinary skill in the art to include the teaching of Broadhurst with Marguiles and Tam in order to allow a user to search for various internet domains, greatly reducing the time it takes to search as supported by Broadhurst (col. 2, lines 25-30).

37. Referring to claim 19, Marguiles in view of Tam disclose the invention substantively as disclosed in claim 1. Marguiles in view of Tam does not specifically disclose charging the user for the reserving of the generated numeric sequence variants. In analogous art, Broadhurst discloses another domain reservation system which charges the user for reserving variants of the domain name (Figure 6C, country by country order form, note request for credit card information). It would have been

obvious to one of ordinary skill in the art to include the teaching of Broadhurst with Marguiles and Tam in order to allow a user to search for various internet domains, greatly reducing the time it takes to search as supported by Broadhurst (col. 2, lines 25-30).

38. Referring to claims 35 and 36, Marguiles in view of Tam disclose the invention substantively as described in claim 1. Marguiles in view of Tam do not specifically disclose presenting to the user at least some of the generated numeric sequence variants for selection of various domain names. In analogous art, Broadhurst discloses another domain name reservation system which presents to the user at least some of the generated numeric sequence variants for selection of various domain names (i.e. search results and "register now" hyperlinks) (Figure 6A, ref. 610). It would have been obvious to one of ordinary skill in the art to include the teaching of Broadhurst with Marguiles and Tam in order to allow a user to search for various internet domains, greatly reducing the time it takes to search as supported by Broadhurst (col. 2, lines 25-30).

Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marguiles in view of Tam in view of Sampson et al. (USPN 6,339,423) (hereinafter Sampson).

39. Referring to claim 31, Marguiles in view of Tam disclose the invention substantively as described in claim 20. Marguiles in view of Tam do not specifically disclose resolving the domain name includes determining information about the domain name by using one or more cookies that are received as part of the request. In analogous art, Sampson discloses another resource resolution system which includes determining information about the domain name by using one or more cookies that are received as part of the request (i.e. authenticate the browser based on cookies received) (col. 7, lines 5-10, 25-30, 50-67). It would have been obvious to one of ordinary skill in the art to combine the teaching of Sampson with Marguiles and Tam in order to manage a set of resources deployed under multiple domain names, thereby reducing the amount of authentication required for each particular resource of the multiple domains as supported by Sampson (col. 3, lines 13-18).

40. Claims 32 and 33 are rejected for similar reasons as stated above (i.e. stored information associated with the second user or the client computer is a cookie as described in claim 31, since the second user is utilizing the client computer, this inherently makes any information on the second computer “information associated with the second user”).

Claims 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marguiles in view of Tan in view of Byrne et al. (USPN 6,408,306) (hereinafter Byrne).

41. Marguiles in view of Tan disclose the invention substantively as described in claim 20. Marguiles in view of Tan do not specifically disclose that, when two domain names match the second user's request, prompting the user to select a name to be used for the resolving. In analogous art, Byrne discloses another domain name resolution system which discloses when two domain names match the second user's request, prompting the user to select a name to be used for the resolving (i.e. multiple domain names are displayed as a list of domain names for the user to choose) (Figure 4D; col. 7, lines 40-55). It would have been obvious to one of ordinary skill in the art to combine the teaching of Byrne with Marguiles and Tan in order for the system of Marguiles and Tan not to fail when multiple entries match (col. 15, lines 13-20). The system modified by Byrne will allow a user to select an appropriate response, with further advantages of having a user specifying distinguished names as supported by Byrne (col. 2, lines 34-35).

Conclusion

42. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

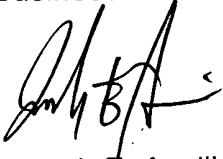
43. Applicant employs broad language, which includes the use of word, and phrases, which have broad meanings in the art. As the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly and as reasonably

possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993). Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the specification, and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph E. Avellino, Examiner
June 25, 2006

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